IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

CUSTOMER NO. 22927

Applicants:	Walker et al.
Application No.:	09/654,933
Filed:	September 1, 2000
Title:	METHOD, APPARATUS, AND PROGRAM FOR CUSTOMIZING CREDIT ACCOUNTS
Attorney Docket No.:	96-108-C2
Group Art Unit:	3624
Examiner:	COLBERT, Ella

PRE-APPEAL BRIEF REQUEST FOR REVIEW
of the rejections in the Final Office Action mailed December 23, 2005

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
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Dear Examiner:

Applicants respectfully request Pre-Appeal Brief Review of the rejections set forth in the Final Office Action mailed December 23, 2005. No amendments are being filed with this Request, and this Request is being filed concurrently with a Notice of Appeal.

This document is filed by Applicants' representative on behalf of the present Applicants for patent. Accordingly, references in this document to "we", "us", "our" and the like will be understood as indicating the present Applicants.

Review is requested for the reasons set forth in the Remarks section that begins on the following page.

REMARKS

I. Introduction

Claims 49-62, 70, and 73-80 are pending in the present application. Claims 49, 61, 62, 70, 73, 74 and 80 are independent claims. All pending Claims stand rejected under 35 U.S.C. §103(a) for allegedly being unpatentable over U.S. Patent No. 5,933,817 (hereinafter "Hucal") and U.S. Patent No. 4,436,442 (hereinafter "Musmanno").

We note that, in the Final Office Action mailed December 23, 2005, the Examiner repeated verbatim all of the 35 U.S.C. §103(a) rejections set forth in the Office Action mailed on July 6, 2005. Thus, we address the new "Response to Arguments" section that begins on page 8 of the Final Action, and where appropriate reference the rejections as they appear in the Final Office Action.

II. The Examiner's "Response to Arguments"

Paragraph 4, on pages 8-12 of the Final Action, lists seven (7) "Issues" concerning our arguments filed on 12 October, 2005, and includes the Examiner's response thereto. We now address each of these in order:

Issue no. 1: Applicants argued that neither Hucal or Musmanno provide support for the Examiners premise that either teaches or suggests *providing an offer to a customer associated with the credit account, wherein the offer comprises an offer to provide the payment to the customer if the customer agrees to the modification of the parameter.*

In the response, the Examiner again failed to provide evidence for her premise, instead focusing on the term "parameter" which appears in pending independent Claims 49, 61, 62 and 80. In particular, the Examiner states that the term "parameter" has been given its broadest reasonable interpretation, but failed to recite how this issue applies to our arguments concerning the cited Hucal and Musmanno references (see Final Action, page 8, lines 3-24). Accordingly, we reassert that Hucal and Musmanno cannot support a finding of obviousness with respect to any of Claims 49, 61, 62, and 80.

Furthermore, the Examiner admits in paragraph 3 on page 2 of the Final Office Action that: *"Hucal failed to teach, providing an offer to a customer associated with the credit account, wherein the offer comprises an offer to provide the payment to the customer if the customer agrees to the modification of the parameter."* The Examiner alleges that Musmanno teaches, at col. 2, lines 32-58 and col. 4, lines 1-17, to provide an offer to a customer associated with the credit account, wherein the offer comprises an offer to provide the payment to the customer if the customer agrees to the modification of the parameter. But col. 2, lines 32-58 describes how "income or receipts...are applied to the overall subscriber's account in a predetermined, hierarchical manner" that maximizes returns or minimizes interest charges. Clearly, this cited portion of Musmanno has nothing to do with providing an offer to a customer that is in any way related to an agreement to modify a parameter, much less a payment to a customer for such agreement to modify. Moreover, col. 4, lines 1-17 of Musmanno also has nothing to do with providing an offer to a customer that is in any way related to an agreement to modify a parameter, much less a payment for such agreement to modify. It should be noted that we

requested clarification concerning what specific language in this paragraph that the Examiner believes is evidence of such features, but this request went unanswered.

Accordingly, we reiterate our argument that, since Musmanno is the only evidence of record offered in support of the Examiner's finding that *providing an offer to a customer associated with the credit account, wherein the offer comprises an offer to provide the payment to the customer if the customer agrees to the modification of the parameter* was known, and since Musmanno cannot support such a finding, no prima facie case of obviousness has been established. Thus, the Section 103(a) rejection of Claims 49, 61, 62, and 80 must be withdrawn.

Issue no. 2: We argued that there was no evidence to support a motivation to combine Hucal and Musmanno, and even if there were some evidence, nowhere is it suggested to modify Hucal to allow for *providing an offer to a customer associated with the credit account, wherein the offer comprises an offer to provide the payment to the customer if the customer agrees to the modification of the parameter.*

The Examiner asserts that the motivation is: *"because such a modification would allow Hucal to provide a customer with special services if the customer complies with the credit regulations and earns a "cashback" benefit on his or her credit account."* [Final Office Action, page 3]. But there is no indication of any evidence of record that supports this alleged motivation. Furthermore, Hucal and Musmanno do not appear to suggest anything related to a "cashback" benefit. There is also no evidence of why one of ordinary skill in the art would have looked to the securities brokerage/cash management system of Musmanno to modify the revolving credit program system of Hucal—the systems do not appear to be analogous, and no evidence is given that they are.

The Examiner argues that providing "cashback" is considered to be an offer, and that the "cashback" provides a payment to the customer if the customer agrees to a modification of the terms of a credit account, which is "well known" in the art of credit cards and credit accounts as an incentative (sic., "incentive") for retaining a customer (Final Office Action, page 9, lines 10-12). We reassert that her position is a convenient assumption that is not supported by the evidence and would not even suggest the specific claimed subject matter. We also reassert that the Examiner has failed to establish a prima facie case of obviousness for at least this reason. Accordingly, we reassert that the Section 103(a) rejections of independent Claims 49, 61, 62 and 80 (and Claims 50-60 dependent from Claim 49) are not supported by substantial evidence and must be withdrawn.

Issue no. 3: We argued that the rejection of Claim 57 failed because the Examiner relied on a finding that was not supported by the only evidence relied on (Hucal and Musmanno). We requested that objective and substantial evidence be made of record to support the Examiner's finding that it was *"well known in the art when applying for credit or a loan, etc. the applicant's (customer's) credit report which includes the past payment history and the income of the customer are always checked and the loan amount (credit) and rate of interest are based mainly on these factors."* (See the Final Office Action, page 5).

In response, the Examiner states: *"Anyone who knows anything about applying for a loan of any type knows that your credit report is pulled to check your FICA score and the loan*

amount (credit) and rate of interest are based on your credit history (credit worthiness)." (Final Office Action, page 9, lines 19-22). We respectfully assert our position, as this unsupported statement by the Examiner does not rise to the level of objective and substantial evidence, and we reiterate our position that a prima facie case of obviousness has not been established. Thus, the rejection of Claim 57 must be withdrawn.

Issue no. 4: With respect to independent Claims 70, 73, and 74, we argued that the cited Musmanno passage at col. 3, lines 49-68, does not teach *determining that a customer associated with a credit account is dissatisfied with the credit account* . In particular, nothing in this cited portion remotely hints at customer dissatisfaction with a credit account. To date, the Examiner has not even attempted to explain how any particular language in this cited portion or otherwise in Musmanno might suggest the claimed subject matter.

In the Final Action, the Examiner states (again with no support in the record) that: *"If a customer is given a credit limit or terms the customer does not agree with the customer would be dissatisfied with the credit account and cancel the credit account."* (repeated in the Final Office Action at page 10, lines 6-8). Thus, no evidence has been supplied that any such subject matter was known, and none given to show any motivation to modify the Hucal system to provide for such features. Thus, we again request that this rejection be withdrawn.

Issue no. 5: We traversed the Examiner's assertion that Hucal teaches the feature of *presenting the customer with an offer to modify the at least one term of the credit account, wherein the offer to modify the at least one term of the credit account includes an offer of the payment.* The cited portion of Hucal (Column 5) does not provide any evidence to support such a finding, but describes different interest rates that may be based on different amounts paid by a customer. This does not suggest a payment to a customer to modify a term of a credit account, or an offer of such a payment in exchange for modifying a term.

In the Final Action, the Examiner states *"It is interpreted that Hucal discloses modifying a term of the credit account includes an offer of the payment by the calculation of the percentage of the balance reduction on the credit account when making a payment."* (Final Office Action, page 10, lines 13-16). We respectfully assert that such a statement is wholly unsupported by the disclosure of Hucal, and still cannot understand how any language of Hucal, Column 5, teaches any such features. Since nothing in Hucal (or Musmanno) suggests that such a feature was known, we respectfully reassert that the rejections of Claims 70, 73, and 74 (and dependent claims 75-79) must be withdrawn for failure to establish a prima facie case of obviousness.

Issue no. 6: With regard to Claim 76, the examiner again relied on a finding that was admittedly unsupported by the only evidence relied on (Hucal and Musmanno). The Examiner is obligated to make of record objective and substantial evidence in support of the finding that it was known (and obvious to provide for) *transmitting to the customer, based on the evaluation, at least one of an acceptance and a rejection of the requested modification.* Since the Examiner failed to do so, we asserted that this rejection of Claim 76 fails.

The Examiner now requests, in the Final Action, for clarification of the claim language: "*Evaluating the requested modification of what? ...Applicants' are respectfully requested to clarify in the claim language what they are trying to claim.*" (Final Office Action, page 11, lines 1-6). We respectfully suggest that the Examiner is now attempting to obfuscate the true problem at issue here, namely the failure to support the assertion that it would have been obvious to provide for such a feature, while at the same time admitting in the Action that none of the cited evidence can support such a finding. (Final Action, page 6, line 20 to page 7, line 5). Thus, the rejection of Claim 76 (and dependent claims 77 and 78) is improper because a prima facie case of obviousness based on substantial evidence has not been made, and this rejection should be withdrawn.

Issue no. 7: We pointed out that, with respect to independent Claim 80, the Examiner erroneously relied on the rejections of Claims 49, 61, and 62. In doing so, the explicit features of *receiving an indication that the customer agrees to the modification* and *providing the payment to the customer after receiving the indication* have been ignored.

In the Final Action, the Examiner states that: "*...it is noted that the features upon which applicant relies (i.e., "providing payment to a customer after receiving an indication of agreement to a modification) are not recited in the rejected claims(s)"* (Final Office Action, page 11, lines 12-16). However, Claim 80 indeed does recite such features. The Examiner apparently misunderstood our argument, but the fact remains that nothing in the cited evidence (Hucal and Musmanno) suggests providing payment to a customer after receiving an indication of agreement to a modification. Consequently, we again assert that the Examiner has failed to establish, with substantial evidence, that all of the claimed subject matter was known, and that any motivation for providing such subject matter was known. Thus, the rejection of Claim 80 should be withdrawn at least for failure to establish a prima facie case of obviousness.

III. Conclusion

Applicants respectfully request review and reversal of all of the Section 103(a) rejections of all of the pending Claims 49-62, 70, and 73-80.

Respectfully submitted,

March 21, 2006
Date

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